

## REMARKS

Upon entry of this Amendment, claims 1-22 are pending in the application. The election of claims 1-22 for prosecution is hereby affirmed. Claims 23-40 are cancelled by this Amendment with leave to file a continuing application in the future.

The Examiner has attached Applicants' information disclosure statement (PTO-1449) and has initialed all U.S. patent documents, but has not initialed the two Japanese patent documents. The Applicants respectfully request that the Examiner initial the Japanese patent documents and forward a copy of the initialed document to indicate consideration of the Japanese patent documents.

The Examiner has rejected claims 1, 9-12, and 20-22 under 35 U.S.C. 103(a) as being unpatentable over E.B. Newill et al. (US 2,093,471) in view of Kirkwood (US 6,021,993) as set forth on pages 4 and 5 of the Office action. According to the Examiner, "it would have been obvious at the time the invention was made to modify the HVAC drive unit disclosed by E.B. Newill et al. and provide it with the isolator configuration disclosed by Kirkwood for the purpose of reducing the vibrations transmitted from the motor."

The Examiner's combination of E.B. Newill et al. and Kirkwood is improper. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Furthermore, there must be a reasonable expectation of success. Finally, the prior art reference or references must teach or suggest all the claim limitations. MPEP 2143. "If proposed modifications would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

E.B. Newill et al. disclose a motor-compressor unit 15 housed within a casing 19. In operation of the unit, the casing rotates or gyrates to rotate a fan 21. In order to permit the casing to gyrate at its upper end, the unit is mounted on a gimbal ring 40 that is supported on

bearings 41. Springs 43 secure the casing 19, via the gimbal ring, to the cabinet frame to permit a free, but limited gyration of the upper end of the casing sufficient to permit the casing to rotate the fan.

Kirkwood discloses multiple embodiments of vibration isolation systems 20, 20', and 20" for an electric motor. The embodiment of Fig. 1 illustrates upper and lower covers 54, 60 of a motor isolating assembly 53 that surrounds the motor 22. A mounting surface 50 is located between the motor isolating assembly and an isolator 40, which helps isolate the motor from the mounting surface 50. The embodiment of Fig. 2 illustrates an isolating band 80 surrounding the motor 22 inside a housing 64. An isolating pad 82 is positioned between the end of the motor and the end of the housing. The embodiment of Fig. 3 illustrates an isolating shroud 86 wrapped around the motor 22 inside the housing 64.

First, the Examiner's proposed combination of E.B. Newill et al. and Kirkwood does not teach or suggest every limitation of independent claims 1 and 12. E.B. Newill et al. do not include a first isolator member configured to be sandwiched between the casing and the end cap as argued by the Examiner. The Examiner refers to the bearing 41 as the first isolator member. The bearing 41 is connected to the gimbal ring 40 to support the gimbal ring on the frame of the cabinet. The bearing 41 is not configured to be sandwiched between the casing 19 and the end cap. As clearly shown in Figs. 2 and 3 of E.B. Newill et al., the bearings 41 are not fit tightly between the casing 19 and any portion of the cabinet that can be considered an end cap. The bearings 41 simply support the gimbal ring 40 on the frame. Kirkwood does not remedy the shortcomings of E.B. Newill et al. For this reason, the Examiner's proposed combination of E.B. Newill et al. and Kirkwood does not teach or suggest each and every limitation of independent claim 1 and independent claim 12.

Second, the Examiner's proposed modification of E.B. Newill et al. to include the isolator configuration disclosed by Kirkwood would not be successful and would render the motor of E.B. Newill et al. inoperable, and therefore unsatisfactory for its intended purpose. The Examiner states that Kirkwood discloses a second isolator member 82 configured to be sandwiched between the casing 22 and the partially closed end of the housing 64. The isolator pad 82 of Kirkwood could not be sandwiched between the casing 19 and the housing of E.B. Newill et al. because sandwiching any isolator members between the casing and housing of E.B. Newill et al. would prevent the gyration of the casing, thereby preventing

rotation of the fan 21. The entire mounting system of E.B. Newill et al. is designed to support the unit 15 such that the casing can gyrate within the housing to rotate the fan. On the other hand, the isolation systems 20, 20', and 20" of Kirkwood are specifically designed to limit any movement of the motor, thereby reducing vibrations transmitted from the motor. If any components of the isolation systems disclosed in Kirkwood were sandwiched between the casing and the housing as claimed, the casing of E.B. Newill et al. could not gyrate and the fan would not operate. For this reason, the Examiner's proposed combination of E.B. Newill et al. and Kirkwood would render the E.B. Newill et al. device inoperable and unsatisfactory for its intended purpose.

Third, if the Examiner's proposed modification of E.B. Newill et al. to include the isolator configuration disclosed by Kirkwood were somehow made to work, the principle of operation of the E.B. Newill et al. unit would necessarily be changed. Sandwiching any isolator members between the casing 19 and the housing of the E.B. Newill et al. device would eliminate the ability of the casing to gyrate. Use of a non-gyrating motor unit changes the principle of operation disclosed in E.B. Newill et al. For this reason, the Examiner's proposed combination of E.B. Newill et al. and Kirkwood is improper.

For these and other reasons not discussed herein, independent claim 1 and dependent claims 2-11, and independent claim 12 and dependent claims 13-22 are allowable.

The Examiner has also rejected claims 2-8 and 13-19 as being unpatentable over E.B. Newill et al. in view of Kirkwood as applied to claims 1 and 12, and further in view of various other references. For the reasons discussed above with respect to independent claims 1 and 12, and for other reasons not discussed herein, dependent claims 2-8 and 13-19 are allowable.

For the reasons set forth above, entry of this Amendment and allowance of claims 1-22 are respectfully requested.

The undersigned is available for telephone consultation at any time.

Respectfully submitted,



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